

### III. REMARKS

Claims 1-19 are pending in this application. By this amendment, claims 1, 9, 17 and 18 have been amended and claim 19 has been added. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

Entry of this Amendment is proper under 37 C.F.R. 1.116(b) because the Amendment: (a) places the application in condition for allowance as discussed below; (b) does not raise any new issues requiring further search and/or consideration; and (c) places the application in better form for appeal. Accordingly, Applicant respectfully requests entry of this Amendment.

In the Office Action, claims 1, 3-9, and 11-18 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Stupek et al. (U.S. Patent No. 5,960,189), hereafter "Stupek," in view of Taylor (U.S. Patent No. 5,721,824), hereafter "Taylor." Claims 2 and 10 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Stupek and Taylor and further in view of "Y2K Compliance and the Distributed Enterprise" by Gowen et al., hereafter "Gowen." Claims 6 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Stupek and Taylor and further in view of "IMS/ESA Sysplex Data Sharing: An Implementation Case Study" by Boyle et al., hereafter "Boyle."

With regard to the 35 U.S.C. §103(a) rejection over Stupck in view of Taylor, Applicant asserts that the combined features of the cited references do not teach each and every feature of

the claimed invention. For example, with respect to independent claims 1, 9, 17 and 18, Applicant respectfully submits that Stupek fails to disclose, *inter alia*, starting in said second host session, a database application having a database of all known second maintenance items. The Office equates this feature in the claimed invention with the upgrade database of Stupek that “...contains information regarding the dependencies between the package and other upgrade objects or packages.” Col. 7, lines 8-10. However, as admitted by the Office, the upgrade database entries in Stupek are limited to data regarding each upgrade package, and, as such, Stupek does not teach that the database includes all known second maintenance items. Office Action, page 3, par. 5. The claimed invention, in contrast, includes “...a database application having a database of all known second maintenance items including prerequisite items and corequisite items corresponding to each of said known second maintenance items.” Claim 1. As such, the known second maintenance items in the database as included in the claimed invention are not limited, as in Stupek, to data respecting a particular upgrade package, but instead the database includes all known second maintenance items, whether the known second maintenance items are included in a particular upgrade package or not. For the above reasons, the upgrade database in Stupek is not equivalent to the database that includes known second maintenance items as included in the claimed invention. Taylor does not cure this deficiency. Accordingly, Applicant requests that the rejection be withdrawn.

With further respect to independent claims 1, 9, 17 and 18, Applicant asserts that Stupek does not teach, *inter alia*, searching said database of known second maintenance items for records matching each of said new third maintenance items that have said prerequisite items and corequisite items. The Office equates the first list of new third maintenance items of the claimed

invention with the "upgrades to the network resources [that] are provided to a service by a distribution medium (not shown), such as a CD-ROM" of Stupek. Office Action, page 6. The Office then attempts to equate the database of known second maintenance items of the claimed invention with the upgrade database. Office Action, page 7. However, the upgrade database of Stupek is specified as being contained on the CD-ROM. Col. 3, lines 44-50. As such, the upgrade database is included in the upgrades to the network resources that are provided by the distribution medium of Stupek and are not a separate component. Col. 3, lines 31-33, lines 44-45, lines 50-52. Under this scenario, a search of the database of known second maintenance items for records matching each of said new third maintenance items as included in the claimed invention would have the upgrade database of Stupek being searched by the upgrades, which also include the upgrade database. Furthermore, Stupek never teaches that the "upgrades" are compared to entries in the upgrade database.

Applicant does not intend to argue that the upgrade database of Stupek is not searched as the Office appears to contend, but instead that Stupek does not specifically teach that the upgrade database is searched using a separate list of new upgrades for items having dependency information. The retrieval of information taught in Stupek is limited to the following two comparisons: "...a) whether or not a particular upgrade package corresponds to a resource on the server, and b) whether or not the version number of the upgrade package matches the version number of the corresponding network resource." Col. 4, lines 20-27. Stupek only reports or displays records that meet those comparisons, whether or not dependencies are present. Col. 4, lines 20-25. The Office argues that the search for dependencies is inherent in the process of the automatic upgrade. Office Action, page 4. However, again, even though dependency

information may be included in the records that are found during the search for the above two comparisons and this dependency information may be used to perform automatic upgrades, the upgrade database is never specifically searched for the dependency information. In summary, Applicant submits that Stupek does not search for dependencies, but only for the factors that indicate the occurrence of a package upgrade independent of the presence or absence of dependencies and displays upgrade information whether or not these dependencies exist. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

With still further respect to claims 1, 9, 17 and 18, Applicant respectfully submits that the cited references do not include adding said corresponding prerequisite items and corequisite items to said first list. The Office admits that Stupek does not expressly disclose this feature. Office Action, page 10. Instead, the Office attempts to rely on Taylor, which teaches “[i]f the dominant package has a dependent package not already installed, the method constructs a trailer script process and an action list. The action list has action entries identifying dependent packages not previously installed.” However, the action entries in the action list of Taylor only identify *dependent packages* not previously installed. As such, the dependent packages are not added to the original list, but instead Taylor creates a new action list. Nowhere, in this passage or elsewhere does Taylor teach that dependent items are added to the initial list of available upgrades. In contrast, the claimed invention includes adding to the “...first list of new third maintenance items...” “...said corresponding prerequisite items and corequisite itcms.” Claim 1. Unlike Taylor, this step expressly adds prerequisite items and corequisite items that have been found in the database search to the original list of new third maintenance items to be installed on

the system. Neither Stupek nor Taylor teach this feature. Accordingly, Applicant requests that the rejection be withdrawn.

With final respect to claims 1, 9, 17 and 18, Applicant respectfully submits that the cited references do not include thereafter ordering, receiving, and applying said items on said order list. The Office admits that the retrieval of appropriate upgrade packages from the distribution medium and supplying of the packages to the server upgrader occurs at the outset. Nowhere does Stupek teach or suggest that this step occurs subsequent to the other steps. In contrast, the claimed invention includes "...thereafter ordering, receiving, and applying said items on said order list." Claim 1. As such, the ordering, receiving, and applying of the items on the order list of the claimed invention does not occur at the outset as in Stupek, but rather thereafter. Taylor does not cure this deficiency. Accordingly, Applicant respectfully requests that the Office withdraw its rejection.

With respect to dependent claims, Applicant herein incorporates the arguments presented above with respect to independent claims 1, 9, 17 and 18 from which the claims depend. Furthermore, Applicant submits that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicant respectfully requests withdrawal of this rejection.

With regard to newly added independent claim 19, Applicant submits that the cited references do not teach or suggest each and every feature of the claimed invention. Accordingly, Applicant submits that the claim is in condition for allowance.

**IV. CONCLUSION**

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,



Ronald A. D'Alessandro  
Reg. No.: 42,456

Date: 5/2/05  
Hoffman, Warnick & D'Alessandro LLC  
Three E-Comm Square  
Albany, New York 12207  
(518) 449-0044  
(518) 449-0047 (fax)